UNITED STATES PATENT AND TRADEMARK OFFICE

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10/550,874	09/27/2005	Henrik Przybilla	AT03 0014US1	1786

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ART UNIT	PAPER NUMBER
2435	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _26 April 2010_.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-17_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-17_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. In view of the Appeal Brief filed on April 26, 2010, PROSECUTION IS HEREBY REOPENED. A new ground of rejections is set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

2. Claims 1-17 are pending.

Priority

3. This application is a national stage entry of PCT/IB04/50358 filed on March 30, 2004, which claims foreign priority to 03100837.8, filed 03/31/2003.

A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if

applicant intends to rely on the filing date of the prior application under 35 U.S.C.

119(e), 120, 121, or 365(c). See 37 CFR 1.78(a).

If the reference to the prior application was previously submitted within the time

period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or

an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference

was submitted in an oath or declaration or the application transmittal letter), and the

information concerning the benefit claim was recognized by the Office as shown by its

inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge

under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference

in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the

specification or an ADS. See MPEP § 201.11.

Claim Objection

4. Claims 1, 10 and 19 are objected to because of the following informalities:

Dependent claims 2-9, 11-15, 17 recites "A granting method", "A data carrier"

and "A modification device" which should be "The granting method", "The data carrier"

and "The modification device" respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5. Claims 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim elements "checking means", "modification means" are means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. The specification only refers in general terms to the functionality of the structure for these elements are without clearly indicating the portions of the specification that describe the corresponding structure for the means elements.

Please note: For a computer-implemented means-plus-function claim limitation that invokes 35 U.S.C. 112, sixth paragraph, the corresponding structure is required to be more than simply a general purpose computer or microprocessor. The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer or microprocessor.

Applicant is required to:

(a)   Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b)   Amend the written description of the specification such that it clearly links or

associates the corresponding structure, material, or acts to the claimed function

without introducing any new matter (35 U.S.C. 132(a)); or

(c)   State on the record where the corresponding structure, material, or acts are

set forth in the written description of the specification that perform the claimed

function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and

2181.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Everett et al. (U. S. Pub. No. 2002/0050528) in view of Richards et al. (US Patent No.

6,230,267) and in view of Kawano et al. (US Patent No. 6,899,277).

As per claim 1, Everett teaches:

A granting method to grant a modification device a modification right to modify an

application in a data carrier [Fig. 9], the method comprising: generation of a first key

information item and of an associated second key information item for a data carrier

identified by a data carrier identification information item [paragraph 0040, 0042, 0076, Fig. 3]; generating of a first master key item and an associated second master key information item in addition to the first key information item and the associated second key information item [paragraph 0033 e.g. CA's public key and CA's secret key]; checking the identification personalization data, allowing of the modification of the application in the data carrier by the modification device [paragraph 0055-0059 Fig. 6, 7]. Everett does not expressively mention checking of the association of the first key information item with the second key information item.

However, in the same field of endeavor, Richards teaches: generating of a first master key item and an associated second master key information item in addition to the first key information item and the associated second key information item [CA's public key and CA's private key col. 8 line 40, col. 10 line 40, in addition to the IC card public/secret key pair]; checking of the association of the first key information item stored in the data carrier with the second key information item from the modification device; allowing of the modification of the application in the data carrier by the modification device in response to a determination that the first key information item is associated with the second key information item [Fig. 1A, 1B, col. 8 lines 1-67, col. 9 lines 1-9, col. 11 lines 13-31, 42-46]; checking of the association between the first master key information item stored in the data carrier with the second master key information item from the modification device; and allowing a modification by the modification device of access rights to the data carrier in response to a determination that the first master key information item is associated with the second master key

information item [col. 10 lines 20-48, Fig. 1A, Fig. 1B, col. 8 lines 1-67, col. 9 lines 1-9,

col. 11 lines 13-31, 42-46].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to combine Richards with Everett to authenticate the IC card,

since one would have been motivated to provide secure transfer technique and to

provide secure IC-card system that allows for the secure transfer of data to the intended

IC card [Richards, col. 2 lines 30-42].

Everett and Richards teach modification of access rights to the data carrier in response

to the determination as above. Everett and Richard do not expressively mention

modifying access rights to at least one interface of the data carrier.

However, in an analogous art, Kawano teaches: modifying access rights to at least one

interface of the data carrier [Figs. 1, 9, 14, 15, col. 6 lines 41-47, col. 10 lines 30-55, col.

12 lines 1-25].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to combine Kawano with Everett and Richards to modify the

interface of the data carrier, since one would have been motivated to provide IC card

and electronic device that can make good use of advantages of the respective

communication interfaces [Kawano, col. 2 lines 43-45].

As per claim 2, the rejection of claim 1 is incorporated and Everett teaches:

wherein the modification right gives the right to install and/or update and/or delete the

application in the data carrier [paragraph 0055, 0025].

As per claim 3, the rejection of claim 1 is incorporated and Everett teaches:

wherein the modification right only gives the right to modify a specific application in the

data carriers [paragraph 0025, 0055, Fig. 6, 7].

As per claim 4, the rejection of claim 1 is incorporated and Everett teaches:

wherein the modification right only gives the right to install an application requiring a

predefined maximum amount of storage space in the data carrier [Fig. 7, paragraph

0061].

As per claim 5, the rejection of claim 1 is incorporated and Everett teaches:

wherein the data carrier identification information item identifies a group of data carriers

[paragraph 0040, 0008].

As per claim 6, the rejection of claim 1 is incorporated and Everett teaches:

wherein the modification right also determines the access rights of the application that is

to be modified in the data carrier to storage areas and interfaces of the data carriers

[paragraph 0056, 0059, Fig. 6].

As per claim 7, the rejection of claim 1 is incorporated and Richards teaches:

wherein the modification of access rights in the data carriers and/or the generation of

further key information items in the data carriers and the modification device is possible

only with the first master key information item stored in the data carrier and only with the

second master key information item stored in the modification devices [col. 10 lines 20-

48, Fig. 1A].

As per claim 8, the rejection of claim 7 is incorporated and Richards teaches:

wherein the first master key information item and the associated second master key

information item only make it possible to modify access rights of a specific application in

the data carrier and/or to generate further key information items in the data carrier and

the modification device in order to modify a specific application [col. 10 lines 20-48, Fig.

1A].

As per claim 9, the rejection of claim 1 is incorporated and Everett teaches:

wherein modification of the application in the data carrier by the modification device of

the data carrier is only permitted when specific properties of the application that is to be

modified are determined paragraph 0055-0059].

7. Claims 10, 11, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Richards et al. (US Patent No. 6,230,267) and in view of Kawano et al. (US Patent

No. 6,899,277).

As per claim 10, Richards teaches:

A data carrier for running at least one application, the data carrier comprising: at least

one interface for the contactless and/or contact communication of information items

[Fig. 1A, 11], computer means for running the at least one application, where

information items communicated via the interfaces or information items stored in the

data carrier are processed [Fig. 11, associated text], and having storage means for

storing a first key information item (e.g. IC card key), a first master key information item

separate from the first key information item (e.g. CA's key) and an associated data

carrier identification information item that identifies the data carrier [Fig. 4, 11, col. 7

lines 63-65, col. 10 lines 39-40, 49-52], checking means for checking a modification

right of a modification device to modify an application in the data carrier via the

interface, where the checking means are designed to check the association of the first

key information item stored in the storage means with the second key information item

output to the data carrier by the modification devices, modification means which,

following confirmation of the modification right of the modification device by the

checking means, are designed to enable modification of the application in the data

carrier by the modification device [Fig. 1A, 1B, 9, col. 10 lines 18-67, col. 11 lines 1-60];

the checking means are further configured to check an association between the first

master key information item stored in the data carrier with the second master key

information item from the modification device; and the modification means are further

configured, upon confirmation of the association of the first master key information item

with the second master key information item, to enable modification of access rights

[col. 10 lines 20-48, Fig. 1A, Fig. 1B, col. 8 lines 1-67, col. 9 lines 1-9, col. 11 lines 13-31, 42-46].

Richards teaches modification of access rights to the data carrier in response to the determination as above. Richards does not expressively mention modifying access rights to at least one interface for the contactless and/or contact communication.

However, in an analogous art, Kawano teaches: at least one interface for the contactless and/or contact communication of information items, modifying access rights to at least one interface of the data carrier [Figs. 1, 9, 14, 15, col. 6 lines 41-47, col. 10 lines 30-55, col. 12 lines 1-25].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Kawano with Richards to modify the interface of the data carrier, since one would have been motivated to provide IC card and electronic device that can make good use of advantages of the respective communication interfaces [Kawano, col. 2 lines 43-45].

As per claim 11, the rejection of claim 10 is incorporated and Richards teaches:

wherein the checking means are designed to confirm a restricted modification right which only gives the right to install and/or update and/or delete the application, in the data carriers [col. 11 lines 42-57].

As per claim 16, Richards teaches:

A modification device for modifying an application in a data carrier, the modification device comprising: at least one interface for the contactless and/or contact

communication of information items to a data carrier [Fig. 1A, 1B] identified by a data carrier identification information item, storage means for storing at least one data carrier identification information item that identifies a data carrier, and an associated second key information item (e.g. IC card key) and a second master key information item (e.g. CA's key) [Fig. 1A, 1B, col. 6 lines 31-63, Fig. 5, col. 8 lines 30-43], and computer means for modifying applications in data carriers via the interface where, in the course of communication with a data carrier identified by a stored data carrier identification information item, the modification right of the modification device is output to the data carrier by communication of the second key information item associated with this data carrier identification information item, whereupon, following confirmation of the modification right by the data carrier, the modification device is authorized and designed to modify the application in the data carrier [Fig. 9, 10, col. 10 lines 17-67, col. 11 lines 1-59], wherein the computer means is further configured to modify access rights to the data carrier in response to a determination that the second master key information item is associated with a first master key information item stored on the data carrier [col. 10 lines 20-48, Fig. 1A, Fig. 1B, col. 8 lines 1-67, col. 9 lines 1-9, col. 11 lines 13-31, 42-46].

Richards teaches modification of access rights to the data carrier in response to the determination as above. Richard does not expressively mention modifying access rights to at least one interface for the contactless and/or contact communication.

However, in an analogous art, Kawano teaches: at least one interface for the contactless and/or contact communication of information items, modifying access rights

to at least one interface of the data carrier [Figs. 1, 9, 14, 15, col. 6 lines 41-47, col. 10 lines 30-55, col. 12 lines 1-25].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Kawano with Richards to modify the interface of the data carrier, since one would have been motivated to provide IC card and electronic device that can make good use of advantages of the respective communication interfaces [Kawano, col. 2 lines 43-45].

As per claim 17, the rejection of claim 16 is incorporated and Kawano teaches the modification device is formed by an operator computer containing the storage means and by a reading device that is connected to the operator computer over a data network, the reading device comprising the at least one interface and at least part of the computer means of the modification devices [Figs. 1, 15, 16].

8.   Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards et al. (US Patent No. 6,230,267) in view of Kawano et al. (US Patent No. 6,899,277) and in view of Everett et al. (U. S. Pub. No. 2002/0050528).

As per claim 12, the rejection of claim 10 is incorporated and Richards does not expressively mention gives the rights to modify a specific application in the data carrier. However, Everett teaches:

wherein the checking means are designed to confirm a restricted modification right which only gives the right to modify a specific application in the data carrier [paragraph 0025, 0055, Fig. 6, 7].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Everett with Richards and Kawano, since one would have been motivated to protect against the improper or undesired loading of application onto IC cards and to provide secure IC-card system that allows for selective availability of smart card applications which may be loaded onto IC cards [Everett, paragraph 0006, 0007].

As per claim 13, the rejection of claim 10 is incorporated and Everett teaches:

the checking means are designed to confirm a restricted modification right which only gives the right to install an application requiring a predefined maximum amount of storage space in the data carrier [Fig. 7, paragraph 0061].

As per claim 14, the rejection of claim 10 is incorporated and Everett teaches:

wherein the checking means are designed to confirm a modification right which determines the access rights of the application that is to be modified in the data carrier to storage areas of the storage means and interfaces of the data carrier [paragraph 0055-0059].

<u>As per claim 15</u>, the rejection of claim 10 is incorporated and Richards teaches the computer means are designed to run an application [Fig. 11, 111- control logic]. Richards doesn't expressively mention Java applet. Examiner takes official notice that the Java applet loaded onto the data carrier (smart card) were well known at the time the invention was made. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to utilize the Java applet for the smart card was well known.

Response to Arguments

Appellant's arguments filed 4/26/10 have been fully considered. In view of Appellant's argument that the combination of Richards and Everett does not teach modifying access rights of an interface of the data carrier (i.e. modifying access rights to *at least one interface for* **the contactless and/or contact communication**), is found persuasive. Newly found references by Kawano et al. is used in combination with the previously cited prior art. Kawano teaches an IC card provided <u>with **a contact-type interface and a non-contact-type interface**</u> as the communication interface as shown in Figs. 1, 12, 15. Based on the result of the comparison/judgment, it utilizes the at least communication interface (contact-type or non-contact type) [Figs. 1, 9, 14, 15, col. 6 lines 41-47, col. 10 lines 30-55, col. 12 lines 1-25]. Therefore, the combination of Everett, Richards and Kawano teaches the claim subject matter. See new ground of rejection above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kawagishi (US 6411200) – Card reader/writer and communication method of card reader writer

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIRAV PATEL whose telephone number is (571)272-5936. The examiner can normally be reached on 8 am - 4:30 pm (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nirav Patel/

Examiner, Art Unit 2435

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435